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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/445,268	04/03/2000	DANIEL RICHARD SCHNEIDEWEND	RCA89068	9731

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PATENT OPERATIONS  
THOMSON LICENSING INC.  
PO BOX 5312  
PRINCETON, NJ 08543-5312

EXAMINER

DEMICO, MATTHEW R

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/445,268	<b>Applicant(s)</b> SCHNEIDEWEND ET AL.	
	<b>Examiner</b> Matthew R Demicco	<b>Art Unit</b> 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to an amendment filed 5/5/04. Claims 1-17 are pending. Claims 1, 6, 11 and 13 are amended.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 17 recites the limitation "removing, automatically, said program from a second list of programs representing purchased programs" in Lines 6 and 7. There is insufficient antecedent basis in the Specification for this limitation in the claim. Applicant claims removing a program from a list of programs to be recorded in response to a user command, and *automatically* removing that program from a list of programs to be purchased if the program is on the list. Referring to Applicant's specification, as amended, the removal from the list of programs to be purchased is not automatic, but instead a manual process wherein the user is prompted (Page 29, Line 22 – Page 30, Line 7) whether to cancel the purchase or not.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-10 and 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent No. 5,850,218 to LaJoie et al.

Regarding Claim 1, LaJoie discloses an apparatus for receiving a plurality of programs comprising a user interface for selecting a program from a plurality of programs and selecting a user action (See Figure 16). LaJoie also discloses a controller, which in response to a first user action for selecting a first program for recording, stores the first program in a first list representing a list of programs to be recorded (Col. 21, Lines 15-23). In response to a second user action for selecting a second program for both purchasing and recording, the controller stores the second program on a second list representing a list of programs purchased and also stores the program on the first list (Col. 29, Lines 33-58 and Figures 12 and 13). Further LaJoie discloses an on screen user option (See Figure 25, 496) indicating that a user can both purchase and record the selected program. In this case, the screen displays the message, "You're attempting to Record a PPV Event," and an option to purchase the event ("Buy" button). This message indicates to the user that they can both purchase and record the event simply by pressing the indicated button. Further, the user is able to use the one-touch recording feature (Col.

29, Lines 33-39) in order to use a single key (Col. 29, Lines 5-10) to create a record timer and be prompted to purchase the event. In this fashion, the user does not have to separately select purchasing and recording options for a program. This reads on the claimed user not having to select one of a purchase and record user option and then select the *other* option in order to record the selected program.

Regarding Claim 2, LaJoie discloses a system as stated above in Claim 1. LaJoie further discloses a system wherein the first list includes a timer conflict indication for programs having a timer conflict (Col. 21, Lines 30-42 and Figure 12).

Regarding Claim 3, LaJoie discloses a system as stated above in Claim 1. LaJoie further discloses a system wherein the first list includes a purchase indication for the second program (See Figure 14).

Regarding Claim 4, LaJoie discloses a system as stated above in Claim 1. LaJoie further discloses a system wherein the controller first determines whether there is a timer conflict between the second program and another program on the first list before storing the second program on the first list (Col. 21, Lines 30-55).

Regarding Claim 5, LaJoie discloses a system as stated above in Claim 1. LaJoie further discloses a system wherein the controller prompts a user to resolve the timer conflict if one exists (Cols. 21-22, Lines 55-5 and Figure 12).

Regarding Claim 6, LaJoie discloses an apparatus for processing a program comprising a controller for displaying a first list representing programs selected for recording (See LaJoie Figure 12), displaying a second list representing programs selected for purchasing (See LaJoie Figure 13) and in response to a user selection of a program for

both purchasing and recording, automatically entering the program into both lists as stated above in Claim 1. Further disclosed is an on screen user control option indicating that a user can both purchase and record a program, so that the user does not have to select one of purchase and record user control options and then select the other user control option to purchase and record the program as stated above in Claim 1.

Regarding Claims 7-10, see Claims 2-5 respectively, as stated above.

Regarding Claim 13, LaJoie discloses a method for processing a plurality of programs comprising the steps of selecting a first program for recording from a plurality of programs, storing the program in a first list, selecting a second program, receiving a selection of a displayed user option indicating that a user can both purchase and record of the selected second program, storing the second program in a second list representing programs purchased, and storing, automatically, the second program in the first list as stated above in Claim 1.

Regarding Claim 14, LaJoie discloses a method as stated above in Claim 13 further comprising the step of determining whether there is a timer conflict between the second program and another program on the first list before storing the second program on the first list as stated above in Claim 4.

Regarding Claim 15, LaJoie discloses a method as stated above in Claim 13 further comprising the step of prompting the user to resolve a timer conflict if one exists as stated above in Claim 5.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11-12 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaJoie et al.

Regarding Claim 11, LaJoie discloses an apparatus for processing a program comprising a user interface means for selecting a program from a plurality of programs with an on screen user option indicating that a user can both purchase and record the problem so that the user does not have to select one of a purchase and record user options and then select the other user option to purchase and record the selected program as stated above in Claim 1. What is not disclosed, however, is a controller that in response to a user action for canceling a program, removes the program from a first list representing a list of programs purchased and automatically removes the program from a second list representing a list of programs to be recorded.

As stated above, LaJoie discloses that a single button may be operable to add an item to two different lists. Further, LaJoie discloses removing a program from a list of programs to be purchased (Col. 22, Lines 25-31) or removing any timer (See Figure 14 and Col. 22, Lines 52-56) including recording timers. Further, LaJoie clearly teaches that one *cannot* record a pay television program without first purchasing it (See Figure 25,

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496). Therefore, it would be obvious that if one cancels the purchasing of the program, it *cannot* be recorded, and therefore should be removed from the recording list.

The claimed one action causing two functions to be performed instead of having to take two separate actions does not constitute a patentable advance in the art. It would be obvious to one having ordinary skill in the art at the time the invention was made that a single button could be used to perform two actions such as removing an item from the two lists of LaJoie since it has generally been recognized that the use of a conventional control to automate a previously manual operation involves only routine skill in the art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). This reads on the claimed controller, in response to a user action for canceling the program, removing the program from a first list representing a list of programs purchased and automatically removing the program from a second list representing a list of programs to be recorded.

Regarding Claim 12, LaJoie discloses an apparatus for processing a program as stated above. LaJoie further discloses an on screen display means for displaying a first list representing programs selected for recording (See Figure 11). Further disclosed is a first user control means for selecting to both purchase and record a program as stated above. LaJoie discloses on screen display means for displaying a second list representing programs selected for purchasing (See Figure 13). LaJoie also discloses a control means for removing a selected program from the first list and second list (see Figure 14), by pressing the “stop” button on each item to be removed (Col. 22, Lines 52-56). Further, as stated above in Claim 11, it would be obvious to provide a control means that, in



response to the user removal of a program from the second list, automatically removes the program from the first list.

Regarding Claim 16, LaJoie discloses a method as stated above. Further, LaJoie discloses selecting a first program for removing from a first list representing a list of programs selected for recording (Col. 22, Lines 54-56). It would be obvious to select a second program for removing from a second list representing a list of programs purchased, determine whether the program appears on the first list and removing, automatically, the second program from the first list if it appears on the first list as stated above in Claim 11.

Regarding Claim 17, as best understood by the Examiner, LaJoie disclose a method as stated above. What is not disclosed, however, is removing, in response to a user command, a program from a first list of programs representing programs scheduled for recording, determining whether the program is also a purchased program, and removing, automatically, the program from a second list of programs representing purchased programs, if the program is a purchased program.

As stated above, LaJoie discloses that a single button may be operable to add an item to two different lists. Further, LaJoie discloses removing a program from a list of programs to be purchased (Col. 22, Lines 25-31) or removing any timer (See Figure 14 and Col. 22, Lines 52-56) including recording timers. The claimed one action causing two functions to be performed instead of having to take two separate actions is not a patentable advance in the art. Further, broadly providing an automatic means to replace a manual activity, which accomplishes the same result (that is, automatically removing an

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item from two lists based on one command instead of two) is not sufficient to distinguish over the prior art (In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)).

Therefore, it would be obvious to one having ordinary skill in the art at the time the invention was made that, based on the teachings of LaJoie, a single button could be used to remove the item from two lists. This reads on the claimed removing, in response to a user command, the program from a first list of programs representing programs scheduled for recording, determining whether the program is also a purchased program, and removing, automatically, the program from a second list of programs representing purchased programs, if the program is a purchased program. In this way, a user will not accidentally end up purchasing a program they are no longer recording and never intended to watch at the time it is aired.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155. The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

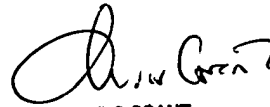
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*MRD*

mrd

January 21, 2005



CHRIS GRANT  
PRIMARY EXAMINER